

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 24-35 are pending in the application, with 24, 25 and 26 being the independent claims. Claims 9-23 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 24-35 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Support for new claims 24-34 can be found, for example, *inter alia* at page 5, lines 1-3, page 8, lines 15-21, page 10, lines 12-21, page 13, lines 17-24, page 15, lines 16-19, page 14, line 1 to page 15, line 2, page 20, lines 15-28 and Figure 7 in the specification and canceled claims 12-23. Claims 27-32 are identical to canceled claims 12-20 except that they are now dependent on a new independent claim.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112, 2nd Paragraph

The Examiner has rejected claims 21 to 23 under 35 U.S.C. § 112, second paragraph as allegedly being incomplete for omitting essential steps. Applicants respectfully traverse the rejection.

The Examiner states that the claims "are incomplete because they do not recite any steps that reflect or account for the difference, if any, between the u-PA activity of the 'cell line which expresses urokinase-type plasminogen activator (u-Pa)' and the 'cell

line which expresses u-PA and which has inhibited Gs signaling of u-PA activity." (Paper No. 20040318, p. 2). Furthermore, the Examiner states that "the claims appear to require the accumulation of experimental data from each of the four sets of cells recited therein, the analytical steps recited in section '(e)' of claim 21 and section '(f)' in each of claims 22 and 23 do not account for these four sets of data." (Paper No. 20040318, p. 3). Applicants disagree.

Solely in an effort to expedite prosecution and without acquiescence in the propriety of the rejection, Applicants have cancelled claims 21-23 and replaced them with new claims 24-26. New claims 24-26 recite a measuring step and a determining step wherein the relative u-PA activity of the cell lines in the claimed method are compared. New claim 24 recites:

(c) measuring the u-PA activity by fluorescence or absorbance spectroscopy of the cell culture supernatant of step (b) and the cell culture supernatant of said first and second cell lines which have not been in contact with said compound of interest;

Furthermore claim 24 recites:

(d) determining whether said compound of interest is an agonist of a receptor which couples to both Gs and Gq proteins thereby affecting an adenylyl cyclase or phospholipase C pathway, wherein the u-PA activity of the supernatant from said first and second cell lines from step (b) is greater than the u-PA activity of the supernatant from said first and second cell lines which have not been in contact with said compound of interest.

Applicants consider step (d) of new claim 24 and step (e) in claims 25 and 26 to account for the data gathered for four sets of cells stated in the respective claims. For example, step (d) in claim 24 states that the u-PA activity from the first and second cell lines, of the claimed method, which have been exposed to the compound of interest are greater than the u-PA activity from the first and second cell lines which have not been exposed to the compound of interest. Thus, Applicants consider the rejection moot and respectfully request that the rejection is withdrawn.

Rejections under 35 U.S.C. § 112, 2nd paragraph

The Examiner has rejected claims 21 to 23 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse the rejection.

Specifically, the Examiner states that "the subject matter encompassed by the limitation, 'a cell line which expresses urokinase plasminogen activator (u-Pa)' includes the subject matter encompassed by the limitation 'a cell line which expresses u-PA and which has inhibited Gs signaling of u-PA activity.'" (Paper No. 20040318, p. 3). Applicants respectfully disagree.

Solely in an effort to expedite prosecution and without acquiescence in the propriety of the rejection, Applicants have cancelled claims 21-23 and replaced them with new claims 24-26. New claims 24-26 refer to a "first and second cell line..., wherein said first and second cell lines express urokinase-type plasminogen activator (u-PA) and said second cell line also has inhibited Gs signaling of u-PA activity."

The Examiner also states that claims 21 to 23 are vague and indefinite because "there is no antecedent basis for 'said cell lines' and 'both cell lines'" and that the text "(c)

introducing said expression vector into both cell lines of step [sic] thereby providing stably transfected cells" is confusing (Paper No. 20040318 , p. 4). Solely in an effort to expedite prosecution and without acquiescence in the propriety of the rejection, Applicants have cancelled claims 21-23 and replaced them with new claims 24-26 which differentiate between the two cell lines in the claimed method as described above and do not recite "said cell lines" or "both cell lines."

Thus, in light of the above arguments and new claims, this rejection is now moot. Applicants respectfully request that the rejection is withdrawn.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 9 to 20 under 35 U.S.C. § 103 as allegedly being unpatentable over the Catanzariti *et al.* *BioTechniques* 15(3):474-479 (1993) ("Catanzariti") in view of the combination of U.S. Patent No. 5,494,806 to Segre *et al.* ("Segre") and the Bringhurst *et al.* *Endocrinology* 132:2090-2098 (1993) ("Bringhurst") publication. Applicants respectfully traverse this rejection.

Solely in an effort to expedite prosecution and without acquiescence in the propriety of the rejection, Applicants have cancelled claims 9 to 20. Thus, the rejection is now moot and Applicants respectfully request that the rejection is withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the

outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Lawrence B. Bugaisky
Attorney for Applicants
Registration No. 35,086

Date: June 21, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600